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FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATION NO. APPLICATION NO. FILING DATE 11/01/2001 Motasim Sirhan 020460-001600US 4760 10/002,595 EXAMINER 20350 7590 04/06/2004 TOWNSEND AND TOWNSEND AND CREW, LLP PHAN, HIEU TWO EMBARCADERO CENTER PAPER NUMBER **ART UNIT EIGHTH FLOOR** SAN FRANCISCO, CA 94111-3834 3738 17 DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	L Application No.	Application	
lacksquare	Application No.	Applicant(s)	
Office Action Summary	10/002,595	SIRHAN ET AL.	
	Examiner	Art Unit	
	Hieu Phan	3738	
The MAILING DATE of this communication a Period for Reply	ppears on the cover sheet with th	ne correspondence address	
A SHORTENED STATUTORY PERIOD FOR REF THE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a re - If NO period for reply is specified above, the maximum statutory perion. - Failure to reply within the set or extended period for reply will, by status any reply received by the Office later than three months after the main earned patent term adjustment. See 37 CFR 1.704(b).	N. 1.136(a). In no event, however, may a reply be eply within the statutory minimum of thirty (30) and will apply and will expire SIX (6) MONTHS ute, cause the application to become ABANDO	be timely filed days will be considered timely. from the mailing date of this communication. DNED (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on 20	January 2004.		
2a) This action is FINAL. 2b) ⊠ Th	nis action is non-final.		
3) Since this application is in condition for allow) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is		
closed in accordance with the practice under	r <i>Ex parte Quayle</i> , 1935 C.D. 11	, 453 O.G. 213.	
Disposition of Claims			
4)⊠ Claim(s) <u>1-273</u> is/are pending in the application.			
4a) Of the above claim(s) is/are withd	rawn from consideration.		
5) Claim(s) is/are allowed.			
6) Claim(s) is/are rejected.	· · · · · · · · · · · · · · · · · · ·		
7) Claim(s) is/are objected to.	to a charatte a considerance at		
8) Claim(s) <u>1-273</u> are subject to restriction and	or election requirement.		
Application Papers			
9) The specification is objected to by the Exami			
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.			
Applicant may not request that any objection to the			
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.			
The dath of declaration is objected to by the	Examiner. Note the attached Of	nce Action of form FTO-132.	
Priority under 35 U.S.C. § 119			
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority docume 2. Certified copies of the priority docume 3. Copies of the certified copies of the priority docume application from the International Bure	ents have been received. ents have been received in Applicationity documents have been received.	cation No	
* See the attached detailed Office action for a li	st of the certified copies not rece	eived.	
AMaahaaa Wal		ADE CCTV	
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Interview Summ	nary (PTO-413)	
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Ma	il Date	
Information Disclosure Statement(s) (PTO-1449 or PTO/SB/0 Paper No(s)/Mail Date	5) Notice of Inform 6) Other:	al Patent Application (PTO-152)	

Application/Control Number: 10/002,595

Page 2

Art Unit: 3738

DETAILED ACTION

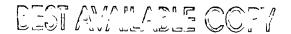
Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121: 1.

- 1. Claims 1-7 and 74-271, drawn to luminal prosthesis, classified in class 623, subclass 1.42.
- Claims 8-73, drawn to method for treating vascular artery, classified in II. class 128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product. For example, the bioactive agents can be release without requiring a layer of cell to grow over the luminal prosthesis.
- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 4. This application contains claims directed to the following patentably distinct species of the claimed invention of Group I (luminal prosthesis):



Application/Control Number: 10/002,595

Art Unit: 3738

Specie 1: figure 2A

Specie 2: figure 2B

Specie 3: figure 2C

Specie 4: figure 2D

Specie 5: figure 2E

Specie 6: figure 2F

Specie 7: figure 2G

Specie 8: figure 2H

Specie 9: figure 21

Specie 10: figure 2J

Specie 11: figure 2K

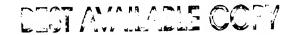
Specie 12: figure 2L

Specie 13: figure 2M

Specie 14: figure 2N

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

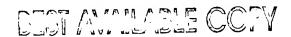


Art Unit: 3738

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- 5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- 6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 7. A telephone call was made to Nena Bains on 04/02/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.



Art Unit: 3738

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Phan whose telephone number is 703-308-8969. The examiner can normally be reached on Monday-Friday from 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

Hieu Phan Examiner Art Unit 3738

David H. Willse Primary Examiner

